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10/806,602	03/22/2004	Pietro Rancan		2448

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EXAMINER

COMPTON, ERIC B

ART UNIT PAPER NUMBER

3726

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/806,602

**Applicant(s)**

RANCAN, PIETRO

**Examiner**

Eric B. Compton

**Art Unit**

3726

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-16 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 7-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Invention I, claims 7-16 and 21-30 with traverse in the reply filed on December 02, 2004, is acknowledged. However, because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-6 and 17-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Drawings***

3. Figures 4A – 4D & 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The Specification, page 6, [0026], indicates these figures show a "prior art process."

***Priority***

4. Applicant should update the status of the priority statement to reflect the issuance of the parent, application no. 09/988,904 as U.S. Pat. 6,708,525.

***Claim Objections***

5. Claim 7 is objected to because of the following informalities: there should be an —and—between the last two method steps. Appropriate correction is required.
6. Claim 8-14 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

These claims are directed towards a method for making a reversible Omega chain. However, they depend from non-elected claims 5-9 drawn to a necklace. The Examiner believes that these claims should depend from independent claim 7, also drawn to a method for making a reversible Omega chain, and is treating them as such for initial Examination purposes.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claim 28 recites the limitation “the first machine” in line 2. There is insufficient antecedent basis for this limitation in the claim.

The Examiner believes this claim should depend from claim 27, which introduces this limitation, rather than claim 26. See also claims 22-23 (claiming essentially the same features). For initial Examination purposes the Examiner is treating claim 28 to depend from claim 27.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 21-25 and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. App. Pub. No. 2002/0029476 and/or U.S. Pat. 6,601,301 to Lacchetti et al ("Lacchetti").

Applicant seeks to provoke an Interference with U.S. Pat. 6,601,301 to Lacchetti et al. See Applicant's Remarks dated August 5, 2004. U.S. Pat. 6,601,301 issued based

Art Unit: 3726

on the application filed, which published as U.S. Pat. App. Pub. No. 2002/0029476.

Thus, Applicant admits the Lacchetti reference discloses the same claimed invention as Applicant.

Regarding claims 21-25, Applicant purposely copied these claims verbatim from claims 1-5 of Lacchetti. See Applicant's Remarks dated August 5, 2004.

Regarding claims 26-30, Applicant merely changed the terms from the language in claims 1-5 of Lacchetti.:

"two-sided" to ~~–omega-double-face–~~ (see Claim 26, line 1);

"pipe section" to ~~–ring–~~ (see Claim 26, line 2);

"pipe" to ~~–tubular element–~~ (see Claim 26, line 3); and

"band" to ~~–laminae—~~ (see Claim 26, line 5).

These terms are merely synonyms in the context of the invention.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2002/0029476 to Lacchetti et al ("Lacchetti") in view of U.S. Pat. 450,412 to Knight and U.S. Pat. 5,611,144 to Gusky.

Lacchetti discloses the a method for making a reversible Omega chain comprising the steps of:

- providing a first strip (3) of a first material;
- providing a second strip (4) of a second material;
- joining the first strip and the second strip together at one lengthwise side (see Figure 1);
- rolling the joined strips to form a hollow tube (19);
- cutting the tube radially at specific increments to provide a plurality of rings (see [0030]); and
- inserting the rings onto a core to form the omega chain (see [0031]).

With respect to the then prior art and forming hollow necklaces and chain, Lacchetti discloses, a “chain is formed by a succession of links which are essentially cylindrical and in general flattened and show an elliptic section. These links are put near each other on a flexible core” and mounted. See [0005]. The Examiner interprets “elliptic” to be a synonym of “oval,” as used by Applicant in the context of the invention.

However, Lacchetti does not specifically disclose the step claimed by Applicant: “drawing the tube over a substantially oval shaping element to form a substantially oval tube” to form the elliptic section and “pressing the rings on the core to provide the omega chain.”

Knight disclose a method for making tubular jewelry stock having the same general configuration and formed by the same steps, e.g., joining two bands together, bending them and welding the seam to form a tube, as the tube of Lacchetti. See

Art Unit: 3726

Figures 1 and 3. The reference further discloses, the "tube is now drawn through a draw-plate, the area of which is less than the area of the sectional outline of the tube, so as to consolidate and lengthen the tube, and the tube is successively drawn through draw-plates or elongated and reduced in thickness by rolling until a tube, rod, or wire of the desired size and cross-sectional is produced." Page 2, Col. 1, lines 2-9. One having ordinary skill in the art at the time of invention recognizes that for a hollow tube, a mandrel is required in a drawing operation such that the tube does not collapse. See *generally*, Choate, Sharr, "Creative Gold- and Silversmith," pages 119-121 (disclosing use of draw-plate in conjunction with a mandrel for forming tubing); U.S. Pat. 5,809,822 to Butty (disclosing forming tube, e.g., jewelry, see Col. 1, lines 19, by using a draw-plate in conjunction with a mandrel); see *also* U.S. Pat, 1,422,974 to Higgins, Col. 1, lines 41-48 (disclosing use of draw-plate in conjunction with a mandrel).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the omega chain of Lacchetti by drawing the tube over a substantially oval shaping element to form a substantially oval tube, in light of the teachings of Knight, in order to form the desired thickness and cross-section of the tube.

However, neither Lacchetti nor Knight discloses pressing the rings on the core to provide the omega chain.

Gusky discloses an Omega chain of the type claimed by Lacchetti. The reference discloses that in the then prior art it was known to place the links on the flexible core and pressed them in place thereby to engage the links on the core and to provide the final cross sectional shape of the chain. See Col. 1, lines 14-31. Gusky

improves upon the prior art by providing an embossed decorative pattern on the surface formed by the pressing step. See Abstract.

Regarding claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the Omega chain of Lacchetti/Knight by performing a final pressing operation to press the rings of the core, in light of the teachings of Gusky, in order to engage the links onto the core, provide the final cross-sectional shape of the claim, and/or to provide an embossed decorative pattern on the surface.

Regarding claims 8, 11-16, these features are disclosed in the prior art cited. See *generally*, Lacchetti and Gusky. Regarding the design features, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have change to design of the jewelry article to make it more aesthetically pleasing. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (aesthetic design changes relating to ornamentation only which have no mechanical function held to be prima facie obvious over prior art).

Regarding claims 9-10, the cordon of Applicant appears to be essentially a welding seam that is later removed by the drawing process. See Specification at [0031]. Applicant has not suggested a benefit of this feature. Lacchetti/Knight rely on a weld seam, which would similarly be removed during the drawing step by the mandrel. The mandrel is "calibrated" in the sense that it provides a desired internal diameter to the tube. See Specification at [0032].

***Interference***

13. Applicant seeks to provoke an Interference with U.S. Pat. 6,601,301 to Lacchetti et al. See Applicant's Remarks dated August 5, 2004. U.S. Pat. 6,601,301 issued August 5, 2003, based on the application filed, which published as U.S. Pat. App. Pub. No. 2002/0029476 under 35 U.S.C. 122(b) on March 14, 2002.

14. 35 U.S.C. §135(b) establishes a one-year bar for Applicant to present a claim for purposes of Interference from the date of publication of the patent or patent application publication. "To establish entitlement to the earlier effective date of existing claims for purpose of the one-year bar of 35 U.S.C. §135(b), a party must show that the later filed claim does not differ from an earlier claim in 'any material limitation.'" *In re Berger*, 61 USPQ2d 1523, 1528 (Fed. Cir. 2002). "The analysis focuses on the copied claim to determine whether all material limitations of the copied claim necessarily occur in the prior claims. If all material limitations of the copied claims are present in, or necessarily result from, the limitation of the prior claims, then the copied claim is entitled to the earlier effective filing date of those prior claims for the purpose of satisfying 35 U.S.C. §135(b)." *Id.*

15. Claims 1-25 were originally filed March 22, 2004 and claims 26-30 were added by the Preliminary Amendment dated August 5, 2004, both within the one-year period of the patent issue, but not the one-year period of the patent application publication. Note: the expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. § 135(b) includes the one-year anniversary date of the issuance of a patent. *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964).

16. Applicant's present application filed March 22, 2004, is a continuation of application no. 09/988,904, now U.S. Pat. 6,708,525 filed November 19, 2001. The '904 application is a continuation-in-part of application no. 09/536,672, now abandoned, filed March 28, 2000.

The '672 application's originally filed claims are directed towards "A Chain for ornamental purposes of the so-called "Omega" type ...." See '672, claim 1, dated March 28, 2000. No claim limitations were directed to a process or method for making such chain. Thus, these claims do not contain "all material limitations of the copied claims."

The '904 application originally filed claims 1-6 are directed to "An ornamental "Omega" type chain ..." and "A process for the production of a necklace prepared form the chain according to claim 1 ..." See '904, claims 1 & 6, dated November 19, 2001. A subsequent amendment was made on July 30, 2002, and corresponding Examiner's amendment with respect to those claims was made on October 22, 2002. Upon review of the originally filed claims and amendments in the '904 application, the Examiner is persuaded that Applicant is entitled to the earlier effective date of the existing claims for purpose of the one-year bar of 35 U.S.C. §135(b), based on the originally filed claims and amendments in '904 application, since they contain "all material limitations of the copied claims."

***Remarks***

17. Due to the objections and rejections of the claims indicated above, this application is not ready for an Interference proceeding at this time. See MPEP § 2306.
18. The 102(e)/103 rejections above based on Lacchetti therefore remain.

***Prior Art References***

The prior art references listed on the enclosed PTO-892, but not used in a rejection of the claims, are cited for their teachings of forming necklaces and/or other jewelry.

U.S. Pats. 6,745,554 & 6,837,036 disclose substantially similar invention. However, due to later effective filing dates they do not constitute prior art.

Applicant's Rule 1.132 declaration filed in the '904 application dated July 30, 2002, was considered by the Examiner.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton  
Primary Examiner  
Art Unit 3726

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